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4 UNITED STATES PATENT AND TRADEMARK OFFICE  
5 BOARD OF PATENT APPEALS AND INTERFERENCES  
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8 Patent Interference 105,624 McK  
9 Technology Center 1600  
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11  
12 IGNATIUS LOY **BRITTO**, IAN C. ASHURST,  
13 CRAIG STEVEN HERMAN, LI LI-BOVET,  
14 and MICHAEL THOMAS RIEBE,  
15

16 Patent 6,511,653 B1,  
17 Junior Party,  
18

19 v.  
20

21 FRANCOIS **BRUGGER** and ANGELIKA STAMPF,  
22

23 Application 10/464,633,  
24 Senior Party,  
25

26  
27 *Before: FRED E. McKELVEY, Senior Administrative Patent Judge, and*  
28 *JAMESON LEE and SALLY C. MEDLEY, Administrative Patent Judges.*  
29

30 McKELVEY, *Senior Administrative Patent Judge.*  
31

32 **DECISION ON MOTIONS**

33 **A. Statement of the case**

34 The interference is before a motions panel for a decision on motions.

35 The Britto Patent 6,511,653 B1 was initially involved with the  
36 Brugger application in Interference 105,482.

1       The Britto patent has been removed from Interference 105,482 and is  
2 now involved in this interference with the Brugger application.

3       Motions previously filed in Interference 105,482 are being considered  
4 in this interference to the extent those motions relate to Britto Patent  
5 6,511,653 B1 and the Brugger application.

6       We assume the reader is familiar with our DECISION ON MOTIONS  
7 entered in Interference 105,482, which we incorporate by reference into this  
8 opinion. Paper 83, Interference 105,482.

9       Additional findings and discussion appear in this opinion limited to  
10 the issues between Britto Patent 6,511,653 B1 and the Brugger application.

11       We have substituted Count B for Count 1 in Interference 105,482.  
12 See Paper 83 in Interference 105,482.

13       Count B is the count in this interference. See Paper 4, pages 1-2.

14       With respect to Ashurst Motion 1 (Paper 31, Interference 105,482),  
15 the issue to be considered in this interference is whether any of the claims of  
16 Britto Patent 6,511,653 B1 should correspond to Count B.

17       A motion to have all of a party's claims designated as not  
18 corresponding to the count is in reality a motion for judgment of no  
19 interference-in-fact.

20       We recognize that a motion for judgment based on no interference-in-  
21 fact was *not* authorized. Paper 24, page 2:19 through page 3:2. The reason  
22 a motion for no interference-in-fact was not authorized at that time was that  
23 the motion would not have applied to all claims of all involved Ashurst and  
24 Britto patents. Now that Britto Patent 6,511,653 B1 has been made the  
25 subject of an interference apart from the other Ashurst patents, consideration  
26 of no interference-in-fact is appropriate. A judgment based on no  
27 interference-in-fact requires a *two-way* test. 37 C.F.R. § 41.203(a) (2007).

1 A motion to designate a claim as not corresponding to a count requires a  
2 *one-way* test, *i.e.*, the subject matter of the claim is not anticipated or would  
3 not have been obvious over the subject matter of the count. The arguments  
4 in support of a no interference-in-fact motion *in this case* are essentially  
5 identical to those involved in a motion to designate claims as not  
6 corresponding to a count because *the subject matter of the Britto claims*  
7 *anticipate at least one Brugger claim and therefore one criteria of the two-*  
8 *way is established.*

9 Britto claims 1-24, all designated as corresponding to Count B,  
10 are limited to MDI devices having a blend coating comprising (1) a  
11 fluoropolymer and (b) a non-fluoropolymer. Ex 1005, col. 10:11 through  
12 col. 12:24.

13 On the other hand, Brugger claims 1-19, all designated as  
14 corresponding to Count B, call for use of a fluoropolymer and do not call for  
15 use of a blend coating including a non-fluoropolymer. Ex 1010.

16 It is Britto's position that an MDI having a blend coating is patentably  
17 distinct from an MDI having only a fluoropolymer coating.

18 Specifically, while Britto concedes that the subject matter of its  
19 claims 1-24 would anticipate or render obvious the subject matter of Brugger  
20 claims 1-19, it is Britto's position that the subject matter of Brugger  
21 claims 1-19 would not anticipate or render obvious the subject matter of  
22 its claims 1-24.

23 In effect, Britto maintains that there is no interference-in-fact between  
24 its claims and claims 1-19 of Britto.

25 **B. Additional findings**

26 The findings made in the decision on motions (Interference 105,482,  
27 Paper 83) apply as well to this interference.

1           In addition, we add some findings with respect to the content of Britto  
2 Patent 6,511,653 B1. Ex 1005.

3           Like the Ashurst patent involved in Interference 105,482, the Britto  
4 patent involved in this interference reveals that drugs for treating respiratory  
5 and nasal disorders are frequently administered in aerosol formulations  
6 through the mouth. Ex 1005, col. 1:16-18.

7           One widely used method for dispensing an aerosol drug formulation  
8 involves making a suspension formulation of the drug as a finely divided  
9 powder in a liquefied gas known as a propellant. Ex 1005, col. 1:18-21.

10          The suspension is stored in a sealed container capable of withstanding  
11 the pressure required to maintain the propellant as a liquid. Ex 1005,  
12 col. 1:21-23.

13          The suspension is dispersed by activation of a dose metering valve  
14 affixed to the container. Ex 1005, col. 1: 23-25.

15          One form of container is a metered dose inhaler, or MDI. Ex 1005,  
16 col. 1:36-39.

17          Some aerosol drugs tend to adhere to the inner surfaces, *i.e.*, can,  
18 valves and caps of the MDI. Ex 1005, col. 1:51-52

19          Britto tells us that he has found that coating the interior can surfaces  
20 of the MDI with a fluorocarbon polymer significantly reduces or essentially  
21 eliminates the problem of drug adhesion or deposition on the MDI can walls  
22 and thus ensures consistent delivery of medication in aerosol form from the  
23 MDI. Ex 1005, col. 1:59-63.

24          The inside of the MDI can is coated with one or more fluorocarbon  
25 polymers, optionally in combination with one or more non-fluorocarbon  
26 polymers. Ex 1005, col. 1:66 through col. 2:2.

27          A surfactant may optionally be present. Ex 1005, col. 2:47.

1       The propellants said to be useful are 1,1,1,2-tetrafluoroethane  
2 (Propellant 134a) and 1,1,1,2,3,3,3-heptafluoropropane (Propellant 227 or  
3 P227). Ex 1005, col. 3:49-53. These two propellants are approved for use  
4 in MDI devices. Ex 1007, page 20, ¶ (105).

5       Most often the MDI can is made of aluminum. Ex 1005, col. 4:1-2.

6       Suitable fluorocarbon polymers include polytetrafluoroethylene.

7 Ex 1005, col 4:31-32.

8       The fluorocarbon polymer may be blended with non-fluorinated  
9 polymers such as polyamides, polyimides, polyethersulfones, poly-  
10 phenylene sulfides and amine-formaldehyde thermosetting resins.

11 Ex 1005, col. 4:46-49.

12       One suitable non-fluorinated polymer is PTEF-PES DuPont 3200-100.

13 Ex 1005, col. 4:61-62.

14       Prophetic Examples 3 and 13 describe the use of PTFE-PES blend  
15 (DuPont). Ex 1005, col. 7 and col. 9.

16       The claims are directed to the use of blend coatings on the interior  
17 surfaces of an MDI.

### 18       **C. Discussion**

19       An interference exists if the subject matter of a claim of one party  
20 (*e.g.*, Brugger claims 1-19) would, if prior art, have anticipated or rendered  
21 obvious the subject matter of a claim of the opposing party (*e.g.*, Britto  
22 claims 1-24) and vice versa. 37 C.F.R. § 41.203(a) (2007).

23       As indicated earlier, the parties do not dispute, and indeed there can  
24 be no dispute, that the subject matter of Britto claim 1 (Ex 1005, col. 10)  
25 would have anticipated or rendered obvious the subject matter of Brugger  
26 claims 9 and 10 (Ex 1010, page 2).

1       The interference-in-fact issue turns on whether the subject matter of  
2 Brugger claims 9 and 10, together with other prior art in the record, would  
3 have rendered obvious the subject matter of Britto claims 1-24.

4       For the reasons given in our DECISION ON MOTIONS in  
5 Interference 105,482, we conclude that the subject matter of Brugger  
6 claims 9 and 10, together with other prior art in the record (including Canada  
7 867), would have rendered obvious the subject matter of Britto claims 1-24  
8 and therefore an interference-in-fact exists.

9       We add the following discussion related to the precise facts of this  
10 interference.

11                               1. Ex parte prosecution

12       An argument made by Britto is that during *ex parte* proceedings Britto  
13 was able to convince the Examiner that its claims were patentable over  
14 Canada 867. Paper 32, page 28, Interference 105,482.

15       Britto correctly recognizes that an *ex parte* decision is not binding in  
16 an *inter partes* case. *Id.* See (1) *Keystone Bridge Co. v. Phoenix Iron Co.*,  
17 5 Otto (95 U.S.) 274, 279 (1877) (the public—in this case Brugger—is not  
18 bound by a decision of the Patent Office to issue a patent); (2) *Sze v. Bloch*,  
19 458 F.2d 137 (CCPA 1972) (holding during *ex parte* examination cannot be  
20 binding in subsequent *inter partes* case involving application in which  
21 holding was made); (3) *Switzer v. Sockman*, 52 CCPA 759, 333 F.2d 935  
22 (CCPA 1964); (4) *Turchan v. Bailey Meter Co.*, 167 F. Supp. 58, 63-64  
23 (D. Del. 1958); and (5) *Glaxo Wellcome Inc. v. Cabilly*, 56 USPQ2d 1983  
24 (Bd. Pat. App. & Int. 2000).

25       Britto concedes that there is evidence before us which was not before  
26 the Examiner.

1           Accordingly, we evaluate the evidence on its merits and make a *de*  
2 *novo* factual analysis on the issue of obviousness.

3           2. Unexpected results and secondary considerations

4           Britto maintains that the claimed invention produces unexpected  
5 results and has been a commercial success.

6           Unexpected results and commercial success are relevant  
7 considerations in evaluating obviousness.

8           We explained in our DECISION ON MOTIONS in Interference  
9 105,482 why we have not been persuaded by allegations of unexpected  
10 results and alleged commercial success.

11          In general, the Britto shows of unexpected results and commercial  
12 success are not commensurate in scope with the breadth of the claims.

13          In this opinion, we believe it appropriate to give some additional  
14 attention to certain claims which limit the non-fluoropolymer to a  
15 polyethersulfone.

16          Why? Because MDI having blend coatings including a  
17 polyethersulfone are said to produce unexpected results and are alleged to  
18 have been a commercial success.

19          For example, Britto claim 11 limits the non-fluorocarbon polymer to  
20 "a polyethersulfone." Claim 13 limits the blend to a perfluorinated ethylene  
21 propylene copolymer (the fluoropolymer) and polyethersulfone (the non-  
22 fluoropolymer). Claim 14 limits the blend to polytetrafluoroethylene and  
23 polyethersulfone.

24          We do not have to make a finding that a *very specific* combination of  
25 a *very specific* fluoropolymer and a *very specific* polyethersulfone may result  
26 in unexpected results or may have been a commercial success.

1       The relevant Britto claims are drawn to a polyethersulfone and not  
2 any specific polyethersulfone.

3       British 851 (Ex 2026) is highly relevant to any evaluation of whether  
4 any unexpected result and/or commercial success of blend coating having "a  
5 polyethersulfone" is commensurate in scope with the breadth of the relevant  
6 Britto claims.

7       The British 851 calls attention to prior art said to be revealed in  
8 British 342. Ex 2026, page 1:23-29.

9       According to British 851, British 342 describes coating compositions  
10 comprising a tetrafluoroethylene polymer and a polyethersulfone having  
11 reduced viscosities of at least 0.3. *Id.*

12       British 851 indicates that satisfactory coatings can be made from the  
13 blend described in British 342. Ex 2026, page 1:35-39.

14       British 851 describes results it says are achieved using a similar blend,  
15 but having a reduced viscosity below 0.25. Ex 2026, page 1:79-85.

16       British 851 goes on to say that British patent specification 1,342,589  
17 (British 589) discloses that polyethersulfones having —OH end groups may  
18 give better adhesion than polyethersulfones having alkoxy ends groups.  
19 Ex 2026, page 2:lines 75-78.

20       The relevant Britto claims are not limited to polyethersulfones having  
21 —OH end groups; in fact the ends groups are not identified in either the  
22 Britto specification or the relevant Britto claims.

23       We do not know whether Britto's "unexpected results" and  
24 "commercial" success are based on polyethersulfones having —OH groups  
25 or a particular viscosity or both.

26       On the one hand, if the Britto results and alleged commercial success  
27 are based on the use of polyethersulfones having —OH end groups, then one



1 can reasonably find that all Britto did was use a known polyethersulfone, in  
2 combination with a fluoropolymer, to obtain a result predicted by British  
3 851. Thus, replacement of the fluoropolymer of Brugger claim 10 with the  
4 blend of British 851 would appear to be a logical step—particularly after  
5 publication of the Canadian patent application.

6 On the other hand, if the Britto results and commercial success are  
7 based on the use of some other polyethersulfone, the Britto patent does not  
8 put that knowledge in the possession of the public. In other words, given  
9 British 851 and the Britto disclosure how does one skilled in the art  
10 duplicate Britto's alleged unexpected results after expiration of the Britto  
11 patent?

12 We are not inclined to credit a showing of unexpected results and  
13 commercial success for a polyethersulfone when the evidence supports a  
14 finding that the nature of the polyethersulfone can have an effect on the  
15 properties of blend coatings containing the polyethersulfone, including  
16 adherence properties.

17 Britto argues that the polyethersulfone claims are "narrow." While the  
18 Britto "argument is superficially plausible, it does not withstand penetrating  
19 [factual] analysis." *Reserve Life Ins. Co. v. United States*, 640 F.2d 368, 374  
20 (Ct. Cl. 1981).

21 When their scope is evaluated in light of highly relevant prior art, it  
22 turns out that what appears at first blush to be superficially narrow includes  
23 numerous embodiments, many of which have not been shown to have  
24 unexpected properties and to have been a commercial success.

25 We also recognize that in prophetic Example 3 (Ex 1005, col. 7) and  
26 in prophetic Example 13 (Ex 1005, col. 9), a DuPont PTFE-PES blend is  
27 described as being useful.

1       Also described in the Britto specification is PTFE-PES DuPont  
2 3200-100. Ex 1005, col. 4:61.

3       We have not been told whether the MDI products which are said to  
4 exhibit unexpected results and are said to have been a commercial success  
5 were made using DuPont 3200-100 or some other particular but unidentified  
6 polyethersulfone.

7       For that matter, we do not know whether prophetic Examples 3 and 13  
8 would be considered as describing the hypothetical use of DuPont product  
9 3200-100.

10       In any event, the relevant Britto claims are not limited to a blend  
11 coating made from DuPont product 3200-100.

12       To the extent that a particular MDI is a commercial success and that  
13 commercial success is considered persuasive with respect to the obviousness  
14 analysis, we would observe that the claim would then be considered to cover  
15 obvious and non-obvious subject matter. A claim broad enough to cover  
16 obvious subject matter is not patentable under 35 U.S.C. § 103. *In re*  
17 *Muchmore*, 58 CCPA 719, 433 F.2d 824 (CCPA 1970); *Muniauction, Inc. v.*  
18 *Thomson Corporation*, No. 2007-1485, slip op. at 14 (Fed. Cir. July 14,  
19 2008) (commercial success may presumptively be attributed to the patent  
20 invention only where the marketed product embodies the claimed features,  
21 and is coextensive with them).

22       **D. Order**

23       Upon consideration of the record, and for the reasons given, it is  
24       ORDERED that Ashurst Motion 1 (Paper 31, Interference  
25 105,482), treated in this interference as a motion for judgment based on no  
26 interference-in-fact, is *denied*.

1                   FURTHER ORDERED that Ashurst Motion 1 (Paper 31,  
2 Interference 105,482), alternatively treated in this interference as a motion to  
3 have all the claims of Britto Patent 6,511,653 B1 designated as not  
4 corresponding to Count B, is *denied*.

5                   FURTHER ORDERED that priority of invention of the subject  
6 matter of Count B is awarded against Ashurst.

7                   FURTHER ORDERED that judgment is entered in a separate  
8 paper. Paper 5.

1 cc (via electronic mail):  
2  
3 Attorneys for Ashurst  
4 (real party in interest  
5 SmithKlein Beecham Corp.):  
6  
7 Gerald M. Murphy, Jr., Esq.  
8 BIRCH, STEWART, KOLASH & BIRCH, LLP  
9 8110 Gatehouse Road, Suite 100 East  
10 Falls Church, VA 22042  
11  
12 Tel: 703-205-8000  
13 Fax: 703-205-8050  
14 Email: mailroom@bskb.com  
15  
16 Peter J. Armenio, Esq.  
17 KIRKLAND & ELLIS LLP  
18 153 East 53d Street  
19 New York, NY 10022  
20  
21 Tel: 212-446-4960  
22 Fax: 212-446-4900  
23 Email: parmenio@kirkland.com  
24  
25 Attorney for Brugger  
26 (real party in interest  
27 Novartis Corporation):  
28  
29 (continued on next page)  
30  
31  
32  
33  
34  
35  
36  
37  
38  
39  
40

1 James J. Kelly, Esq.  
2 OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C.  
3 1940 Duke Street  
4 Alexandria, VA 22314  
5  
6 Tel: 703-412-6485 (direct)  
7 Fax: 703-413-2220  
8 Email jkelly@oblon.com  
9  
10 Gregory C. Houghton, Esq.  
11 NOVARTIS CORPORATION  
12 Corporate Intellectual Property  
13 One Health Plaza, Building 430  
14 East Hanover, NJ 07936-1080  
15  
16 Tel: 862-778-2614 (direct)  
17 Fax: 973-781-8064  
18 Email: gregory.houghton@novartis.com  
19